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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,638	09/22/2000	HISAO NAKAGAWA	862.C2006	8163

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EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/667,638

Applicant(s)

NAKAGAWA ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/30/2000.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This action is responsive to communications: Election filed 06/18/2004 to the original application filed 09/22/2000; IDS filed 10/30/2000.
2. Claims 1-10 are currently pending in this application. Claims 1 and 9-10 are independent claims.
3. Applicant is required to cancel non-elected claims 11-60 in the next response to this office action.

***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on applications # **11-272951, 11-272952, 11-272953 and 11-272986** filed in Japan on 09/27/1999, which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "*the old document information*" (claim 3, line 20) lacks antecedent basis.

***Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

7. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by **Igarashi et al.** (U.S. 6,484,195 – filed 02/2000, foreign priority filed 07/1996).

**As to independent claim 9:**

Igarashi teaches a method of controlling an information processing apparatus for submitting document information including an image via a network (*e.g., control apparatus to exchange information ... using a network; col.3, lines 25-33*), comprising:

- a. storing input schedule information of predetermined image input means (*e.g., the information received by the receiving includes image sensing schedule information; col.24, lines 51-53*);
- b. storing an image obtained in accordance with the schedule information (*e.g., stores the obtained image ... the image obtained by programmed image sensing; col.5, lines 24-51 /the image data, obtained by programmed image sensing and stored as a file; col.8, lines 34-43 and Fig.5*); and
- c. creating new document information by substituting an image in the document information by the image stored in said image storage means (*e.g., an HTML document is generated with image data description ...perform the programmed image sensing, and stores the obtained image data ...transferred in the designated format; col.5, lines 10-35*).

**As to independent claim 10:**

It is directed to a storage medium for implementing the method of claim 9, and is similarly rejected under the same rationale.

**As to independent claim 1:**

It is directed to an information processing apparatus for performing the method of claim 9, and is similarly rejected under the same rationale. Additionally, Igarashi further teaches image input means (*e.g., video-image input unit 1018; Fig.1*).

**As to dependent claim 2:**

Igarashi teaches transferring the document information created by the document creation means to a network server (*e.g., the client transfers a URL description to the server; col.21, lines 57-67*).

**As to dependent claim 3:**

Igarashi teaches designating an image in the old document information to be changed by an image newly stored in the image storage means (*e.g., converts the image stored in the image memory with the reservation code into a newly designed format data; col.5, lines 24-59/col.7, lines 5-17*).

**As to dependent claim 4:**

Igarashi teaches displaying control means for displaying the changed image in a different pattern (*col.8, lines 11-34*).

**As to dependent claim 5:**

Igarashi teaches when an image in the document information is selected, displaying that image in a pattern different from other images (*col.17, lines 4-54*).

**As to dependent claim 6:**

Igarashi teaches storing an image prepared in advance, and submitting an image in the document information, which is not changed by the image prepared in advance (*Fig.20 and the associated text*).

**As to dependent claim 7:**

Igarashi teaches the document information is HTML document information (*e.g., HTML document; col.4, lines 35-38/col.5, lines 10-35*).

**As to dependent claim 8:**

Igarashi teaches the input schedule includes an image sensing position and time (*col.4, lines 1-58*).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Masunaga et al.	U.S Patent No. 5,742,329	issued: Apr. 21, 1998
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Kohno et al.	U.S Patent No. 5,819,300	issued: Oct. 06, 1998
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Igarashi et al.	U.S Patent No. 6,067,571	issued: May 23, 2000
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Igarashi et al.	U.S Patent No. 6,469,737	issued: Oct. 22, 2002
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
December 24, 2004



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER